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SNAY, J

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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 08/665,491
Filing Date: 18 June 1996
Appellant(s): Kramer, Ronald A.

Samuel B. Laferty
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 17 September 1998.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Art Unit: 1743

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 04/06/98 has been entered.

The amendment after final rejection filed on 05/07/98 has been entered.

The amendment after final rejection filed on 09/17/98 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The brief states that claims 13, 15-18 and 20 stand or fall together. **(8) *Claims***

Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 1743

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

3,998,643	LIDDLE	12-1976
3,956,174	PALCHER	05-1976
3,978,010	BRIGHT ET AL	08-1976

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

Art Unit: 1743

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liddle in view of Palcher.

Liddle discloses a method for treating non-porous surfaces, including glass and plastic, comprising applying a composition which includes an alkylpolysiloxane, an aromatic or aliphatic sulfonic acid, and hydrofluoric acid. The treatment is disclosed as being effective for rendering the surface water repellent, dirt repellent, and frost and ice repellent (see column 4, lines 1-34). Liddle teaches an automobile windshield as a particular surface to be treated.

Liddle differs from the claimed invention in that it fails to teach applying the composition to a windshield wiper. However, Palcher teaches treatment of rubber, e.g. automobile tires, with an alkylpolysiloxane composition to protect against environmental conditions such as ozone and UV radiation. It would have been obvious to one of ordinary skill in the art to apply the treating method of Liddle to windshield wipers, as well as the disclosed windshield, in order to obtain the water and dirt repellency as taught by Liddle, and to further obtain the rubber protection against environmental damage, as taught by Palcher.

Claims 15-18 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Liddle in view of Palcher, as applied to claim 13 above, and further in view of Bright et al.

The method of Liddle as modified in view of Palcher differs from the claimed invention in that it fails to teach the particular sulfonic acids of instant claim 15. However, the selection of known aromatic sulfonic acids based on their suitability for the intended purpose in the method of

Art Unit: 1743

Liddle is considered obvious and within the level of ordinary skill in the art. In this regard, Bright et al is relied upon solely as evidence that sulfonic acids of the type recited in the instant claims were known as useful in cleaning compositions.

(11) Response to Argument

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant further argues that Liddle is directed to treatment of non-porous surfaces only, while Palcher omits sulfonic acid from the treating solution. The argument is not persuasive because the instant claims make no reference to whether a porous or non-porous material is treated, and one of ordinary skill in the art would have reasonably expected the significantly similar treatment compositions of Liddle and Palcher to be effective on both types of materials, i.e. glass and plastic as per the teaching of Liddle and rubber as per the teaching of Palcher.

Appellant further argues that application of the composition of Liddle, as modified in view of Palcher, would have resulted in a decrease of coefficient of friction between the wiper blade and the windshield, rather than an increase of such coefficient of friction as envisioned by the

Art Unit: 1743

instant invention. This argument is not persuasive because neither the instant claims nor the originally filed specification provide any disclosure of a desired or accomplished effect with respect to coefficient of friction. Furthermore, the instant claims require only the application of sulfonic acids to a wiper blade, with no exclusion of additional components and no statement of intended result or purpose. Therefore, the prior art disclosure of the same application of sulfonic acids would inherently have accomplished those results encompassed by the broad scope of the instant claims.

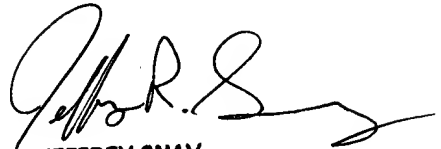
The remainder of appellant's arguments assert the prior art as lacking sufficient motivation to combine the teachings. However, it is noted that only a reasonable expectation of success is needed to establish sufficient motivation. In this case, one of ordinary skill would have reasonably expected the significantly similar compositions of Liddle and Palcher to provide the treatment effects disclosed in those references on both types of materials, i.e. porous and non-porous.

Art Unit: 1743

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

jrs
December 7, 1998


JEFFREY SNAY
PRIMARY EXAMINER

12/7/98

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